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### The Digital Threat to the Normative Role of Copyright Law

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*Current digital technology has radically enhanced the ability to create digital images of copyrighted works and to replicate, manipulate, modify, and transmit and distribute such images on a massive scale. The intellectual property legal structure, particularly the United States copyright laws, while purporting to contemplate and embrace technological change and advance, in fact cannot adequately deal with current technological reality. The ease with which a variety of acts of large-scale copyright infringement can take place, and the frequency of such activity, call into question whether present copyright law can effectively serve a normative function. The article attempts to examine the role of law in this context.*

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The revolution in information technology is changing access to information in fundamental ways. Increasing amounts of information are available in digital form. Networks interconnect computers around the globe; and the World Wide Web provides a framework for access to a vast array of information, from favorite family recipes and newspaper articles to scholarly treatises and music, all available at the click of a mouse. Yet the same technologies that provide vastly enhanced access also raise difficult fundamental issues concerning intellectual property, because the technology that makes access so easy also greatly aids copying—both legal and illegal. As a result, many of the intellectual property rules and practices that evolved in the world of physical artifacts do not work well in the digital environment.<sup>1</sup>

#### I. INTRODUCTION: PIRATE STORIES

A recent newspaper story<sup>2</sup> was devoted to the activities of CD “pirates”—individuals who copy commercial CDs containing copyrighted music onto blank

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<sup>1</sup> COMM. ON INTEL. PROP. RIGHTS AND THE EMERGING INFO. INFRASTRUCTURE, NAT’L RESEARCH COUNCIL, THE DIGITAL DILEMMA: INTELLECTUAL PROPERTY IN THE INFORMATION AGE, at ix (2000) [hereinafter DIGITAL DILEMMA]. The executive summary of *The Digital Dilemma* is reprinted in this issue. 62 OHIO ST. L.J. 951 (2001).

<sup>2</sup> Brian E. Zittel, *The Pirates of Pop Music Fill Streets With \$5 CD’s*, N.Y. TIMES, Sept. 9,

CDs,<sup>3</sup> which are then sold on street corners to passersby, many of whom are regular customers. The sellers, by copying the CDs and distributing the copies, clearly have infringed the rights of the copyright owners of the music contained in the CDs (the composers, authors, and publishers of the works) and the copyright owners of the sound recordings embodied in the CDs (the producers of the recordings). There is no mystery or subtlety here, or close question of law: the Copyright Act is unequivocal in vesting in these respective copyright owners the exclusive right to make such copies and to distribute them.<sup>4</sup> Moreover, while there may well be some public confusion with respect to the legality of noncommercial copying,<sup>5</sup> there is no reason to believe that similar confusion exists with respect to blatantly commercial copying and distribution. Both the sellers and buyers know that they are dealing in unlawfully created commodities. Nevertheless, when a customer was asked why he regularly patronizes one of these street corner vendors he replied: "Everybody buys from [him]. The quality is very good. He's reputable and he's honest."<sup>6</sup>

According to another story in the *New York Times* "about a million otherwise law-abiding adult citizens are demonstrating no compunction about using the service [of Napster, an Internet service linking computers to exchange copyrighted music among unrelated individuals] to get free what they would have to pay for in a record store."<sup>7</sup> As one potential investor in the service put it, "If I believe the new model [of music distribution] is a better way for artists to operate, that is a moral justification for feeling good about investing in Napster . . . even though technically what they're doing is facilitating illegal behavior."<sup>8</sup> One user of the service framed the moral issue succinctly: "But how illegal is it, really? . . . Is it illegal if you go three miles over the speed limit? . . . So yeah, you're breaking the law, but how big a law is it?"<sup>9</sup>

These simple interchanges demonstrate a sharp dissonance between the law as perceived by the public and the moral impact of the law on conduct.<sup>10</sup> Of course,

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1999, at E1.

<sup>3</sup> "Music 'pirates' use digital recording technology to make and to distribute near perfect copies of commercially prepared recordings for which they have not licensed the copyrights." Recording Indus. Ass'n of Am. v. Diamond Multimedia Sys. Inc., 180 F.3d 1072, 1073 (9th Cir. 1999).

<sup>4</sup> 17 U.S.C. § 106 (1994 & Supp. IV 1998).

<sup>5</sup> See *infra* Part III.A.

<sup>6</sup> Zittel, *supra* note 2.

<sup>7</sup> Amy Harmon, *Potent Software Escalates Music Industry's Jitters*, N.Y. TIMES, Mar. 7, 2000, at A1.

<sup>8</sup> *Id.*

<sup>9</sup> *Id.*

<sup>10</sup> As a member of the music industry observed: "There's an incredible disconnect out there between what is normal behavior in the physical world versus the online world. . . . There are people who think nothing of downloading entire CD collections on Napster who wouldn't dream of shoplifting from Tower Records." *Id.*

such dissonance, to one degree or another, has long been part of society and societal response to specific laws.<sup>11</sup> Concomitantly, complex legislation such as the law of copyright, can easily give rise to a fair amount of misunderstanding. For example, notwithstanding the fact that the Copyright Act in general does not exculpate “private” copying, “widespread (and incorrect) belief prevails in society that private use copying is always or almost always lawful.”<sup>12</sup> So too, people generally are surprised to learn that singing *Happy Birthday* in a public restaurant is an infringing act. But the dissonance that goes beyond such misunderstanding is quite different, in that it revolves around an active disregard for the law. Such disregard has always existed to some extent, as individuals, with a wink and a nod, make copies of rented videotapes or of borrowed computer software. The problem, however, has potentiated with the growth of digital technology. Although the CD started to replace vinyl records about fifteen years ago, it is only quite recently that the technology for making virtually perfect copies of a CD became widely available at an affordable price. The general availability of expert-level tools for manipulating digital images similarly is a recent phenomenon. Digital video, digital sound, and digital imaging provide the wherewithal both for extraordinary creativity with respect to the creation of works of the mind and for incredibly easy reproduction, manipulation, and distribution of such works. Adding the Internet to the mix as a digital distribution tool providing virtually instantaneous access to millions of users serves to make the problem one of huge universal dimensions. As the newly released National Research Council report—*The Digital Dilemma*—observes:

The information infrastructure—by which we mean information in digital form, computer networks, and the World Wide Web—has arrived accompanied by contradictory powers and promises. . . . It is at once a remarkably powerful medium for publishing and distributing information, and the world’s largest reproduction facility.

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Information in digital form has radically changed the economics and ease of reproduction. Reproduction costs are much lower for both rights holders (content owners) and infringers alike. Digital copies are also perfect replicas, each a seed for further perfect copies. One consequence is an erosion of what were once the natural barriers to infringement, such as the expense of reproduction and the decreasing quality of successive generations of copies in analog media. . . . Computer networks have radically changed the economics of distribution. With transmission speeds approaching a billion characters per second, networks enable sending information products worldwide, cheaply and almost instantaneously. As a consequence, it is easier and less expensive both for a rights holder to distribute a work and for individuals or pirates to make and distribute unauthorized copies.

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<sup>11</sup> The American experience with Prohibition is the most glaring example.

<sup>12</sup> DIGITAL DILEMMA, *supra* note 1, at 214.

Today, some actions that can be taken casually by the average citizen—downloading files, forwarding information found on the Web—can at times be blatant violations of intellectual property laws.<sup>13</sup>

In the past, it took some effort to make infringing copies of copyrighted works or to create unauthorized derivative works. It took even greater effort, and expense, widely to distribute such copies or works. The efforts, and particularly the time involved, created a framework in which the individual might pause to consider the implications of his or her conduct and balance moral imperative and expediency. The proliferation of home computers, with the capability of easily copying material, created a breach in this framework. Now, as we have moved to a “digital” paradigm and a World Wide Web of vast interconnectivity, the framework is largely gone: “The information infrastructure makes private infringement of [intellectual property] rights vastly easier to carry out and correspondingly more difficult to detect and prevent. As a result, individual standards of moral and ethical conduct, and individual perceptions of right and wrong, become more important.”<sup>14</sup>

Individual determinations of moral and ethical conduct require a moral and ethical context. The problem for intellectual property law in general, and the law of copyright in particular, is the lack of such an underlying clear context. The nature of American copyright law makes it difficult, if not impossible to find or to construct an unambiguous moral compass.

## II. THE INHERENT CONTRADICTIONS OF A LAW FOUNDED ON COMPROMISE

Our copyright law arises out of a grand compromise, reconciling the need to encourage the creative process by protecting the interests of authors, and the public need for access to the product of the creative process. The compromise begins with the Constitution. Congressional power to act with respect to copyright (and patent) is derived directly from Article I of the Constitution: “The Congress shall have Power . . . To promote the progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive right to their respective Writings and Discoveries.”<sup>15</sup>

Thus, the power is granted to create the copyright monopoly, but “for limited Times,” and for a limited purpose—promotion of “the progress of Science and useful

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<sup>13</sup> *Id.* at 2–4.

<sup>14</sup> *Id.* at 21; see Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283, 285 (1996):

Digital technology threatens to upend copyright’s already uneasy accommodation of public access with private ownership. Once a creative work is freely available online, anyone can, with a few clicks of a mouse, make perfect digital copies and limitless digital variations, and can electronically distribute them to the ends of the earth.

<sup>15</sup> U.S. CONST. art. I, § 8, cl. 8.

Arts.” The compromise continued with congressional implementation of the power by specific enumeration of the bundle of rights held by a copyright owner,<sup>16</sup> an enumeration that, by its very nature both grants an array of specific rights and, by implication, excludes other rights:

Copyright law strikes a precarious balance. To encourage authors to create and disseminate original expression, it accords them a bundle of proprietary rights in their works. But to promote public education and creative exchange, it invites audiences and subsequent authors to use existing works in every conceivable one that falls outside the province of the copyright owner’s exclusive rights. Copyright law’s perennial dilemma is to determine where exclusive rights should end and unrestrained public access should begin.<sup>17</sup>

Compromise and balance pervades the Copyright Act; it reflects a legislative history characterized by a continuing balancing of strongly represented interests.<sup>18</sup> For example, section 109 of the Act<sup>19</sup> codifies the “first sale” doctrine, an exception to the copyright owner’s exclusive right publicly to distribute a work,<sup>20</sup> giving the lawful owner of a copy of a copyrighted work the unlimited right to transfer or otherwise dispose of that copy without the consent of the copyright owner. Under this provision, lawful copies of copyrighted books, videotapes of copyrighted motion pictures, and similar works may be sold, transferred, or rented. However, responding to the concerns of the record industry and of publishers of computer software, Congress amended that section to make the first sale doctrine inapplicable to the commercial rental of records or computer software.<sup>21</sup> Similarly, as a general matter, copyright protection does not extend to utilitarian works and industrial design.<sup>22</sup> This doctrine served to preclude protection for architectural works (as opposed to architectural drawings and plans); but Congress, responding both to the need to conform to the Bern Convention and to sharp criticism of the existing state of the law, passed the Architectural Works Copyright Protection Act of 1990, which protects architectural works, separating them from the general exclusion of utilitarian works.<sup>23</sup>

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<sup>16</sup> 17 U.S.C. § 106 (1994 & Supp. IV 1998).

<sup>17</sup> Netanel, *supra* note 14, at 285.

<sup>18</sup> See generally Jessica D. Litman, *Copyright, Compromise, and Legislative History*, 72 CORNELL L. REV. 857 (1987).

<sup>19</sup> 17 U.S.C. § 109 (1994 & Supp. IV 1998).

<sup>20</sup> § 106(3).

<sup>21</sup> Record Rental Amendment of 1984, Pub. L. No. 98-450, 98 Stat. 1727 (1984) (codified as amended at 17 U.S.C. § 109(b) (1994 & Supp. IV 1998)).

<sup>22</sup> See generally SHELDON W. HALPERN ET AL., FUNDAMENTALS OF UNITED STATES INTELLECTUAL PROPERTY LAW: COPYRIGHT, PATENT, AND TRADEMARK § 2.4.4 (1999).

<sup>23</sup> Architectural Works Copyright Protection Act, Pub. L. No. 101-650, 104 Stat. 5133 (1990) (codified as amended at 17 U.S.C. § 102(8) (1994)) (adding “architectural works” to the enumeration of “works of authorship”).

While the process of continuing congressional compromise has been criticized as being too responsive to the needs of specific and influential interest groups,<sup>24</sup> it is also responsive to the continuing need to reexamine the law as conditions change. For good or ill, this legislative give-and-take plays an important and continuing role in the development of the law; it serves as a flexible tool and a tool for giving the law flexibility. This rather pragmatic flexibility in the details of copyright law, however, also makes it difficult to find moral imperatives in those details. The law, in essence, says not "thou shalt not copy," but "thou shalt not copy certain works, under certain circumstances, which may change from time to time."

#### A. *Congress, the Copyright Act, and Technology*

Although congressional tinkering is a long-standing practice, the fundamental copyright law was largely unchanged for a period of almost seventy years until the major revision culminating in the Copyright Act of 1976.<sup>25</sup> In that revision, Congress attempted to create a comprehensive structure flexible enough to accommodate technological change and cover virtually any kind of creative activity. Explicit recognition of the need to deal with emerging technology was found only in contemporaneous congressional creation of the National Commission on New Technological Uses of Copyrighted Works whose task was to determine what, if any, special legislation was needed to deal with computer software.<sup>26</sup> Ultimately, the Commission's deliberations resulted in minimal recommendations, which Congress adopted: the inclusion in the Act of a definition of a computer program,<sup>27</sup> (the effect of which was to qualify a computer program, if sufficiently original, for protection as a "literary work")<sup>28</sup> and special provisions relating to permissible copying.<sup>29</sup> Apart from these minor adjustments, it was assumed that the Act could cope with any technological changes or any new technologies that may be developed in the future.

The unintended consequences that arise from the process of compromising conflicting interests and the assumption that the existing law can accommodate

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<sup>24</sup> See, e.g., Jessica D. Litman, *Copyright Legislation and Technological Change*, 68 OR. L. REV. 275 (1989).

<sup>25</sup> Act of Oct. 19, 1976, Pub. L. No. 94-553, 90 Stat. 2541 (1976) (codified as amended in scattered sections of 17 U.S.C.).

<sup>26</sup> National Commission on New Technological Uses of Copyrighted Works, Pub. L. No. 93-573, 88 Stat. 1873 (1974).

<sup>27</sup> 17 U.S.C. § 101 (Supp. IV 1998) (defining the computer program as "a set of statements or instructions to be used directly or indirectly in a computer in order to bring about a certain result").

<sup>28</sup> See, e.g., *Apple Computer, Inc. v. Franklin Computer Corp.*, 714 F.2d 1240, 1249 (3d Cir. 1983) (holding that "a computer program . . . is a 'literary work'").

<sup>29</sup> 17 U.S.C. § 117 (Supp. IV 1998) (providing a limited exception to the exclusive right of copyright owners to control the copying of computer programs).

technological change, are glaringly apparent in the congressional response to industry concerns over the development of digital audio technology. While the music industry had long railed against private audio taping of phonograph records,<sup>30</sup> that concern was alleviated somewhat with the rapid displacement of phonograph records by CDs; an analog audio tape of a digital CD could not approach the sound quality of the original.<sup>31</sup> However, the development of digital audio tape recorders, with the ability to make virtually perfect copies with no degradation from generation to generation, produced a reaction, perhaps verging on panic, that resulted in congressional passage of the Audio Home Recording Act of 1992.<sup>32</sup> These provisions, essentially directed at wholesale recording of copyrighted musical works, seek to prevent sequential copying—the making of digital copies of digital copies of a digitally recorded work—and impose royalty obligations on sales of recording equipment and tape. On the assumption that these provisions would alleviate the serious problems, that Act expressly immunizes from liability non-commercial digital or analog copying of musical recordings.<sup>33</sup>

In the event, whether because of or in spite of the Home Recording Act, there has not developed an appreciable consumer market for digital audio taping in the United States. The widespread digital copying through the use of the equipment described by that Act and foreseen by the record industry did not occur. Rather, completely different problems, arising out of an unanticipated technology, have produced results far more serious for the music industry. Focusing on digital tape technology, neither Congress nor the music industry was prepared for the distribution of music through the Internet. Although the “uploading” of copyrighted music to an Internet website is an infringing “distribution,”<sup>34</sup> considerable controversy existed over whether the immunities in the Home Recording Act extended to “downloading” by a consumer or the copying of that downloaded material from a computer hard drive onto a CD or other device. While there had been judicial language supporting the exemption,<sup>35</sup> it

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<sup>30</sup> This concern was the basis for the amendments to the “first sale” provisions relating to rental of records, discussed *supra* note 21 and accompanying text.

<sup>31</sup> *Recording Indus. Ass’n of Am. v. Diamond Multimedia Sys., Inc.*, 180 F.3d 1072, 1073 (9th Cir. 1999) (“For example, when an analog cassette copy of . . . a compact disc is itself copied by analog technology, the resulting ‘second-generation’ copy of the original will most likely suffer from the hiss and lack of clarity characteristic of older recordings.”).

<sup>32</sup> 17 U.S.C. §§ 1001–1010 (1994 & Supp. IV 1998).

<sup>33</sup> § 1008.

<sup>34</sup> *See A & M Records, Inc. v. Napster, No. 0016401, No. 0016403*, 2001 U.S. App. LEXIS 1941, at \*1 (9th Cir. 2001).

<sup>35</sup> *See Diamond Multimedia*, 180 F.3d at 1079:

As the Senate Report explains “[t]he purpose of [the Act] is to ensure the right of consumers to make analog or digital audio recordings of copyrighted music for their *private, noncommercial use*.” . . . The Act does so through its home taping exemption, *see* 17 U.S.C. § 1008, which

has most recently been held that "the Audio Home Recording Act does not cover the downloading of MP3 files to computer hard drives."<sup>36</sup>

To rub salt into the wound created by these unintended consequences, it has been held that an MP3 recorder or similar device designed to record from an individual's computer is not the kind of equipment subject to the limitations and royalty provisions of that Act.<sup>37</sup> The immunities—the product of an attempt to deal comprehensively with one perceived technological threat—together with the fact that it is now easy and inexpensive to make perfect copies of CDs, have now produced the exact phenomenon that Congress had thought it had avoided, the proliferation of perfect sequential copies of copyrighted music without the payment of royalties.<sup>38</sup> Neither Congress nor the interested parties contemplated a "revolutionary new method of music distribution made possible by digital recording and the Internet; . . . the brave new world of Internet music distribution."<sup>39</sup>

### B. *Playing Catch-Up: Escalating Technology Wars*

One of the exacerbating problems related to the dissonance between legal proscription and normative conduct is the use of technology to alter the ground rules. Rather than rely simply on finding and prosecuting claims of copyright infringement, the copyright owner attempts to find a way physically to prevent copying of the work, only to be confronted with further advances in technology designed to defeat the protection scheme. This seemingly endless game of catch-up, as encryptors and decoders leapfrog one another, takes place usually in a context in which there is a large class of consumer-infringers (as well as consumers who are not infringers) who either do not consider the copying involved to be an infringing act or do not believe that the law ought to inhibit or punish their conduct. The matter is further complicated by the fact that copyright owners of consumer-directed products generally do not choose to use the cumbersome machinery of litigation against the individual

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"protects all noncommercial copying by consumers of digital and analog musical recordings," H.R. Rep. 102-873(I), at \*59.

*Id.* (alterations in original).

<sup>36</sup> *Napster*, 2001 U.S. App. LEXIS 1941, at \*50.

<sup>37</sup> *Diamond Multimedia*, 180 F.3d at 1079 ("the Act seems designed to allow files to be 'laundered' by passage through a computer").

<sup>38</sup> In *Diamond Multimedia*, the court stated:

These technological advances have occurred, at least in part, to the traditional music industry's disadvantage. By most accounts, the predominant use of MP3 [digital compression technology used on the Internet] is the trafficking in illicit audio recordings. . . . Various pirate websites offer free downloads of copyrighted material, and a single pirate site on the Internet may contain thousands of pirated audio computer files.

*Id.* at 1074.

<sup>39</sup> *Id.*



consumers, but prefer to concentrate on those who provide the wherewithal for the consumers to make their copies.

For example, in the early days of consumer software development it was quite common to sell copy-protected software—software containing code that prevented the user from making a usable copy of the software. The schemes were created to prevent piracy, the unlawful copying of the software. Copy protection through such encryption was overkill in that it also served to prevent lawful copying; nevertheless, it served as a reasonably useful prophylactic. However, in short order software was developed to unlock or otherwise evade the copy protection schemes. The creation of such software was not itself an act of copyright infringement; liability, if any, in connection with the sale of that software could take the form only of a claim for contributory infringement. The fact that the evasive software could be used for substantial *noninfringing* purposes, such as the making of a *lawful* archival copy by the lawful owner of the original copy of the software,<sup>40</sup> served to defeat any contributory infringement claim.<sup>41</sup>

Similarly, in order to prevent unlawful copying, producers of videotaped motion pictures (and, more recently, DVDs) encode the tape or DVD to prevent making of usable copies. In the case of videotape, this fortress almost immediately became vulnerable; for a relatively low price, one could buy a “black box” which, when connected between a playback and a recording VCR, would produce a clean copy of the copyrighted motion picture. Again, while the individual making the copy would be liable for infringement if pursued, the manufacturer and distributor of the “black box” could be liable only if the standards for contributory infringement were met; manufacturing and/or distributing the device to defeat the copy-protection system was not itself actionable outside of the parameters of contributory infringement.

Digital technology has significantly enhanced the ability of copyright owners of digital material to encrypt the material. Where the material is distributed digitally and available through digital networks, such encryption can effectively not only prevent copying in the traditional sense, but can serve effectively to limit access to the material itself, even for otherwise lawful purposes. Obviously, the same digital technology used to encrypt may also be used to de-encrypt, to decode and evade the encryption scheme. One would expect, once again, to find technological leapfrogging between the encryptors and the decoders.

Congress, however, has altered the balance with passage, in late 1998, of the Digital Millennium Copyright Act (DMCA).<sup>42</sup> Among other provisions, that Act, in bringing United States copyright law into harmony with the European Union, specifically makes it actionable to “circumvent a technological measure that

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<sup>40</sup> 17 U.S.C. § 117 (Supp. IV 1998).

<sup>41</sup> See, e.g., *Vault Corp. v. Quaid Software, Ltd.*, 847 F.2d 255 (5th Cir. 1988).

<sup>42</sup> Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended in scattered sections of 17 U.S.C. (Supp. IV 1998)).

effectively controls access to a [copyright protected] work," or to "traffic in any technology, product, service, device, component, or part thereof," that circumvents technology that effectively controls access to a copyrighted work or otherwise protects any rights of a copyright owner.<sup>43</sup>

The DMCA was the product of intense negotiations and compromise among various interested groups. That compromise can be seen in a number of specific exemptions for certain kinds of "circumvention" activities. Other activities are proscribed even if access and/or copying would otherwise be permissible but for the act of circumvention. The Act, both in its proscriptions and exemptions, responds specifically to a variety of parochial concerns. However, in that specificity may lie the source of considerable difficulty in the future as present technology changes. Indeed, in its specific response, both to the needs of copyright owners to use encryption technology and to the concerns about the further use of de-encryption technology, the DMCA may well serve further to widen the gap between widespread conduct and legal precepts and thereby further to attenuate the normative role of copyright law.<sup>44</sup>

### C. *The Peculiar Problem of Visual Works*

#### 1. *Generally*

By the very nature of the legislative process, technology will always be ahead of the law and it is a difficult task to craft a law, or for the courts to interpret the law, fully to accommodate technological change. Consider some of the problems created by technological change in applying traditional copyright doctrine to visual works.

To be constitutionally protected under the Copyright Act, a work must be the "writing" of an "author." Beginning with the 1884 United States Supreme Court opinion in *Burrow-Giles Lithographic Company v. Sarony*,<sup>45</sup> holding that a photographer may be an "author" whose photograph is a "writing," there has been a consistent expansive interpretation of these terms. With the Supreme Court's defining statement that "[a]n author . . . is [one] to whom anything owes its origin,"<sup>46</sup> it has readily been accepted that visual artists, sculptors, composers, photographers, and other expressive creators using tools other than the written word, are "authors," whose works, if appropriately fixed, are "writings" in the sense constitutionally required for protection.<sup>47</sup>

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<sup>43</sup> § 1201(a)(1)(A); § 1201(a)(2), (b)(1). See generally HALPERN ET AL., *supra* note 22, § 11.2.

<sup>44</sup> Cf. DIGITAL DILEMMA, *supra* note 1, at 221–23.

<sup>45</sup> 111 U.S. 53 (1884) (involving a photograph of Oscar Wilde).

<sup>46</sup> *Id.* at 57–58.

<sup>47</sup> See, e.g., 17 U.S.C. § 102(a) (1994):

Works of authorship include the following categories:

For copyright protection to attach to a fixed "writing" it must be an "original work of authorship."<sup>48</sup> The Supreme Court has made it clear that "[o]riginality remains the *sine qua non* of copyright," a constitutional prerequisite to copyrightability.<sup>49</sup> "Originality" is a complex construct, embodying both the concept of independent origin and a minimal level of creativity, a modest amount of intellectual labor: "Original . . . means only that the work was independently created by the author (as opposed to copied from other works), and that it possesses at least some minimal degree of creativity."<sup>50</sup> However, "the requisite level of creativity is extremely low; even a slight amount will suffice."<sup>51</sup> In short, "[t]he least pretentious picture" can meet the originality standard.<sup>52</sup>

Photography has been the source of doctrinal development and implementation of the constitutional constructs of "writing," "author," and "originality." The recent application of sophisticated digital technology to photography (and other visual techniques) has created concern and confusion as to the applicability and limits of what had been established doctrine. *Sarony* was decided in the early days of photography, and the Court's opinion was informed by the then state of an art which involved a high degree of skill (and effort) and creative decision making. "[T]he particular portrait at issue in that case was sufficiently original—by virtue of its pose, arrangement of accessories in the photograph, and lighting and the expression the photographer evoked—to be subject to copyright."<sup>53</sup> While the *Sarony* court

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- (1) literary works;
  - (2) musical works, including any accompanying words;
  - (3) dramatic works, including any accompanying music;
  - (4) pantomimes and choreographic works;
  - (5) pictorial, graphic, and sculptural works;
  - (6) motion pictures and other audiovisual works;
  - (7) sound recordings; and
  - (8) architectural works.

<sup>48</sup> *Id.*

<sup>49</sup> *Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc.*, 499 U.S. 340, 348 (1991).

<sup>50</sup> *Id.* at 345. "The requirement of originality actually subsumes two separate conditions, i.e., the work must possess an independent origin and a minimal amount of creativity." *Baltimore Orioles v. Major League Baseball Players*, 805 F.2d 663, 668 (7th Cir. 1986). "A work is original if it is the independent creation of its author. A work is creative if it embodies some modest amount of intellectual labor." *Id.* at 668 n.6.

<sup>51</sup> *Feist*, 499 U.S. at 345. In *Atari Games v. Oman*, the court reversed denial of registration of a simple geometric "paddle" video game. 979 F.2d 242, 247 (D.C. Cir. 1992). Judge (now Justice) Ruth Bader Ginsburg emphasized how minimal the creativity standard is: "We are mindful . . . of the teaching of *Feist* that '[t]he vast majority of works make the [copyright] grade quite easily.'" *Id.*

<sup>52</sup> *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 250 (1903); *cf.* *Mazer v. Stein*, 347 U.S. 201, 214 (1954) ("Individual perception of the beautiful is too varied a power to permit a narrow or rigid concept of art.").

<sup>53</sup> *The Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F. Supp.2d 191, 195 (S.D.N.Y. 1999);

expressly left open the doctrinal question whether “the ordinary production of a photograph” invariably satisfies the originality requirement, the passage of time, along with the enormous advances in photographic technology, essentially replaced analytic dissection of a particular photograph with a categorical rule: all but the most mechanical photographs contain sufficient originality and creativity for copyright protection.<sup>54</sup>

The development of this doctrine antedated the nearly universal phenomenon of auto-focus, auto-exposure, auto-wind photography. The result is the identical treatment, for purposes of copyrightability, of the carefully framed and created photograph and the impulse-driven, tossed off point-and-shoot image. Each will be considered an “original work of authorship” entitled to full copyright protection. Can this doctrinal democracy be justified as we move to fully digital image creation, which, to a large extent, produces greater transparency between photographer and subject—even greater than that provided by auto-focus, auto-exposure, auto-wind, point-and-shoot photography?

The decision to grant the copyright monopoly indiscriminately in these circumstance may require reconsideration of the long-standing doctrine of “nondiscrimination.” That doctrine recognizes the limits of judicial capability; the court is not the appropriate place to make aesthetic distinctions or judgments. As the Supreme Court observed in *Bleistein v. Donaldson Lithographing Co.*, “[i]t would be a dangerous undertaking for persons trained only to the law to constitute themselves final judge of the worth of pictorial illustrations, outside of the narrowest and most obvious limits.”<sup>55</sup> The aesthetic merit or societal worth of a work is irrelevant to a determination of copyrightability. Simply stated, *any* “original work of authorship” that is fixed in a tangible medium expression will receive copyright protection. With two cases, straddling the end of the nineteenth century, the Court set out the basis for an expansive and evenhanded approach to copyrightability; an approach that, theoretically, at least, is devoid of value judgment, and predicates the grant of the copyright monopoly upon the most minimal standards compatible with the constitutional mandate.

Certainly, the capability problem—the difficulty of making sound aesthetic judgment—has, if anything, been intensified by the enormously increased output of

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see also *Time, Inc. v. Bernard Geis Assoc.*, 293 F. Supp. 130 (S.D.N.Y. 1968) (finding originality in the photographer’s decision as to the camera angle, lighting, the choice of film, exposure speeds, focus, and variety of other factors that go into producing the finished product); *Rogers v. Koons*, 960 F.2d 301, 307 (2d Cir. 1992) (“Elements of originality . . . may include posing the subjects, lighting, angle, selection of film and camera, evoking the desired expression, and almost any other variant involved.”); *Leibovitz v. Paramount Pictures Corp.*, 137 F.3d 109, 116 (2d Cir. 1998) (quoting *Rogers*, 960 F.2d at 307).

<sup>54</sup> See *Bridgeman*, 36 F. Supp. 2d at 196 (holding that there is broad scope for copyright in photographs because “a very modest expression of personality will constitute sufficient originality”) (footnote omitted).

<sup>55</sup> 188 U.S. 239, 251 (1903).

visual imagery. Nevertheless, with the enhanced potential for image creation, manipulation, and dissemination provided by digital technology it may be necessary to rethink the evenhanded nondiscriminatory and nonjudgmental approach to the vesting of exclusive rights. The available digital tools today may be used equally for the virtually mindless arranging and rearranging of pixels and for the truly creative production of a visual image; the "creative" process may require little or no real effort. While the Supreme Court has made clear that copyright is to be based upon some minimal degree of intellectual creativity rather than effort, expense, or workmanlike skill,<sup>56</sup> the social cost of treating the resulting digital creations equally may well exceed the cost of making informed aesthetic distinctions.

## 2. Creativity in Derivative Works

The Copyright Act vests exclusively in the copyright owner the right to create derivative works.<sup>57</sup> At the same time, the Act recognizes that a derivative work may itself be copyrightable independently of the work upon which it is based.<sup>58</sup> "Derivative work" is defined as "a work based upon one or more preexisting works."<sup>59</sup> Because "art reproduction" is specifically included in the Act's definition of a derivative work,<sup>60</sup> it follows both that reproduction of a copyrighted art work without consent of the copyright owner is an act of infringement and that such reproduction may itself be a copyrighted work to the extent of "the material contributed by the author" of the reproduction. The use of digital technology to reproduce or to transform visual works has resulted in the need to rethink the conventional doctrine concerning both what is an infringing derivative work and what kind of "contribution" will be sufficient to give the creator of the reproduction or transformation a copyright interest in the resulting work.

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<sup>56</sup> See generally *Feist*, 499 U.S. at 340.

<sup>57</sup> 17 U.S.C. § 106(2) (1994).

<sup>58</sup> § 103:

(a) The subject matter of copyright . . . includes . . . derivative works . . .

(b) The copyright in a . . . derivative work extends only to the material contributed by the author of such work, as distinguished from the pre-existing material employed in the work, and does not imply any exclusive right in the pre-existing material.

<sup>59</sup> § 101:

A "derivative work" is a work based upon one more pre-existing works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgement, condensation, or any other form in which the work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications which, as a whole, represented an original work of authorship, is a "derivative work."

<sup>60</sup> *Id.*

a. *Infringement by Creation of Derivative Works*

Vesting in the copyright owner of a work the exclusive right to create derivative works appears to be a necessary corollary of the copyright monopoly. The transformation of Shaw's *Pygmalion* from the stage to the screen, and the subsequent further transformation into the stage musical *My Fair Lady* and then the motion picture version of that musical, involved the serial creation of derivative works, each building on the other and each requiring consent of the copyright owners of the preceding works.

However, the derivative right may also be an invitation to confusion in the creative process. Artistic, creative works are often the product of various influences, direct and indirect, blatant and subtle. The exclusive right to prepare a derivative work does not serve as an omnibus shield against any and all misappropriation; it protects against the taking, through one or another form of transformation, of the creative expression contained in the underlying work, as in, for example, the transformation of a novel into a motion picture. To be an infringing derivative work, "the infringing work must incorporate a portion of the copyrighted work in some form."<sup>61</sup> The latter work must incorporate, to some extent *expressive* material from the underlying work.

While it is clear that copyright protects only the original *expression* of an idea and not the idea itself,<sup>62</sup> the determination of what, in any given work, is "expression" and what is "idea" is an extraordinarily subtle and complex task, in which the standards and criteria exist only at the highest analytic level. If copyright protection were limited only to the *literal* expression in a work, the task of determining infringement would be relatively simple. The law, however, developed in a much more expansive direction, making it clear that the copyright in a work extends beyond literal expression to the sufficiently developed non-literal, structural aspects of the work.<sup>63</sup> "Two works need not be identical in order to be deemed 'substantially similar' for purposes of copyright infringement. . . . Both literal and nonliteral similarity may warrant a finding of copyright infringement."<sup>64</sup> Where a taking involves the nonliteral elements of a work, the line between evocation or use of ideas

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<sup>61</sup> H.R. REP NO. 94-1476, at 62 (1976); S. REP. NO. 94-473, at 58 (1975); *see also* Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc., 964 F.2d 965 (9th Cir. 1992) (holding that the manufacturer of "Game Genie," which allowed player to alter features of Nintendo's copyrighted games, was not a derivative work).

<sup>62</sup> 17 U.S.C. § 102 (1994). *See generally* HALPERN ET AL., *supra* note 22, § 2.3.3.

<sup>63</sup> This fundamental proposition was initially set out by Judge Learned Hand in two early opinions that have set the analytic basis for determination of infringement: *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930); *Sheldon v. Metro-Goldwyn Pictures Corp.*, 81 F.2d 49 (2d Cir. 1936).

<sup>64</sup> *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, n.25 (11th Cir. 1996); *see also* *Twin Peaks Prods. Inc. v. Publ'ns Int'l Ltd.*, 996 F.2d 1366, 1372 (2d Cir. 1993) ("substantial similarity can take the form of 'fragmented literal similarity' or 'comprehensive nonliteral similarity'" (citation omitted)).

and copying of protected expression is by no means clear. In the case of works of visual art, where one literally builds upon the work of another, it may often be a difficult task to determine where "homage" ends and unlawful taking begins.

This problem, of course, is not new and arguments have been raised against the application of derivative-works liability to transformative visual art.<sup>65</sup> However, the widespread and relatively inexpensive availability of digital image manipulation tools adds a new and more complex dimension to that old problem. For example, one may now easily create a digital copy of a work (by scanning, by downloading from the Internet or by any of a large variety of techniques) and then, with image editing tools, transform that image so radically that the final product on its face bears virtually no resemblance to its source. The initial copying would be an infringing act if done without consent.<sup>66</sup> Would the digital transformation be an infringing derivative work, even if the original copying were done with consent? Given the wide availability of digital images with respect to which the copyright owner has granted permission for consumer, personal copying and use, the problem of digital transformation that essentially consumes and transfigures the underlying work in the creation of the derivative work is by no means academic.

The final product may certainly be artistic, aesthetically pleasing, and the result of creative use of the available tools well beyond the simple appropriation of another's work. The analytic models that have been developed in the law of copyright with respect to derivative works generally do not contemplate the kind of transformation now made possible through digital techniques, a consumptive transformation by which the expressive elements of the underlying work are largely unrecognizable. Nevertheless, the fact that the new work in fact physically incorporates expressive elements of the old would appear to be sufficient to make it an infringing derivative work.<sup>67</sup> That may be a sound result in terms of policy, but if so it should not be the product of the mindless application of doctrine developed in a different technological milieu. Rather, we need serious discussion of how this transformative technology has an impact upon our generally understood ideas of

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<sup>65</sup> For an extreme statement of the position, see, e.g., Louise Harmon, *Law, Art, and the Killing Jar*, 79 IOWA L. REV. 367 (1994).

<sup>66</sup> Even the "intermediate" copying of the original in the creation of a work that does not ultimately contain the copyrighted material can be infringing. See, e.g., *Sega Enters. Ltd. v. Accolade, Inc.*, 977 F.2d 1510, 1518–19 (9th Cir. 1992).

<sup>67</sup> See, e.g., *Lewis Galoob Toys, Inc. v. Nintendo of Am., Inc.*, 964 F.2d 965, 967 (9th Cir. 1992):

A derivative work must incorporate a protected work in some concrete or permanent "form." . . .

. . . The examples of derivative works provided by the [Copyright] Act all physically incorporate the underlying work or works. The Act's legislative history similarly indicates that "the infringing work must incorporate a portion of the copyrighted work in some form."

*Id.* (citations omitted).

"copying." Certainly, a work that borrows only the general ideas or general structural themes of an earlier work to evoke the original would not be considered an infringing derivative work. It is at least arguable that a work that, while incorporating an earlier work's expressive elements, so transforms them that they cannot readily be found in the new work, is similarly an evocative work but not an infringing "derivative work."<sup>68</sup>

Of course, this example also has implications for the doctrine of fair use. The general matter of fair use is outside the scope of this paper; however, it may well be that expanded fair use constructs can be applied to works that are the product of digital manipulation to produce a workable result. For example, the Ninth Circuit has held:

[while] disassembly [of computer software] is wholesale copying that falls squarely within the category of acts that are prohibited by the statute . . . where disassembly is the only way to gain access to the ideas and functional elements embodied in a copyrighted computer program and where there is a legitimate reason for seeking such access, disassembly is a fair use of the copyrighted work, as a matter of law.<sup>69</sup>

In language particularly relevant to the larger issue of the relationship between technological exigencies and copyright doctrine, the court observed: "We are not unaware of the fact that to those used to considering copyright issues in more traditional contexts, our result may seem incongruous at first blush."<sup>70</sup>

From the infancy of copyright protection, [the fair use doctrine] has been thought necessary to fulfill copyright's very purpose, "[t]o promote the Progress of Science and useful Arts." . . . "[I]n truth, in literature, in science and in art, there are, and can be, few, if any, things, which in an abstract sense, are strictly new and original throughout. Every

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<sup>68</sup> It has been suggested that a new work cannot be considered an infringing derivative work if it is not "substantially similar" to the underlying work. *See, e.g., Litchfield v. Spielberg*, 736 F.2d 1352, 1356 (9th Cir. 1984). However, in general, the "substantial similarity" test is used to determine infringement in the absence of direct proof of copying; access and substantial similarity together provide circumstantial evidence of copying. Where, as in the hypothetical situation posited here, the copying, and physical incorporation is conceded, the relevance of a substantial similarity inquiry is questionable.

<sup>69</sup> *Sega*, 977 F.3d at 1525, 1518, 1527–28. *Sega* was followed in *Sony Computer Entertainment, Inc. v. Connectix Corp.*, 203 F.3d 596 (9th Cir. 2000). *Sega* was expressly adopted in *Bateman v. Mnemonics, Inc.*, 79 F.3d 1532, 1540 n.18 (11th Cir. 1996) ("We find the *Sega* opinion persuasive in view of the principal purpose of copyright—the advancement of science and the arts."). *See Atari Games Corp. v. Nintendo of Am. Inc.*, 975 F.2d 832, 843 (Fed. Cir. 1992) ("reverse engineering object code to discern the unprotectable ideas in a computer program is a fair use").

<sup>70</sup> *Sega*, 977 F.2d at 1527.



book in literature, science and art, borrows, and must necessarily borrow, and use much which was well known and used before.”<sup>71</sup>

As Benjamin Kaplan observed more than thirty years ago:

[I]f man has any “natural” rights, not the least must be a right to imitate his fellows, and thus to reap where he has not sown. Education, after all, proceeds from a kind of mimicry, and “progress,” if it is not entirely an illusion, depends on generous indulgence of copying.<sup>72</sup>

The Supreme Court has made it clear that the concept of “transformative” use lies at the heart of fair use analysis; that the greater the degree of creative transformation of an underlying work, the more appropriate is the application of the defense of fair use:

[T]he goal of copyright, to promote science and the arts, is generally furthered by the creation of transformative works. Such works thus lie at the heart of the fair use doctrine’s guarantee of breathing space within the confines of copyright, . . . and the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use.<sup>73</sup>

Certainly, this language does not arise in the context of the wholesale appropriation of the entirety of a copyrighted work, and it would strain the fair use doctrine to immunize one who engages in such appropriation simply by reframing the work of another or transforming it into another medium.<sup>74</sup> However, the fair use doctrine does need to accommodate the creative transformative possibilities that digital technology affords. Such accommodations can perhaps provide a greater degree of synchrony between behavior and the law.

To that end, it is perhaps necessary to shift the focus of “copying” analysis from the process by which a transformative work is created to the end product itself. While such a shift may be actuated by the fact that a great many people have both lawful access to large libraries of works of visual art in digital format and highly sophisticated tools for manipulating those images, there is a more compelling need for reconsideration. The law of copyright, if it is to have normative force, must also recognize and foster the creative potential arising from that technology. This is essential if the law indeed is to serve the broad purpose behind the constitutional copyright grant.

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<sup>71</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 575 (1994) (second alteration in original) (footnote omitted) (quoting U.S. CONST., art. I, § 8, cl. 8; *Emerson v. Davies*, 8 F. Cas. 615, 619 (C.C.D. Mass. 1845) (Story, J.)).

<sup>72</sup> BENJAMIN KAPLAN, *AN UNHURRIED VIEW OF COPYRIGHT* 2 (1967).

<sup>73</sup> *Campbell*, 510 U.S. at 579.

<sup>74</sup> *Rogers v. Koons*, 960 F.2d 301, 310 (2d Cir. 1992).

The primary objective of copyright is not to reward the labor of authors, but "to promote the Progress of Science and useful Arts." . . . To this end, copyright assures authors the right to their original expression, but encourages others to build freely upon the ideas and information conveyed by a work.<sup>75</sup>

*The Digital Dilemma*<sup>76</sup> suggests, more broadly:

[E]xploring whether or not the notion of copying is an appropriate foundation for copyright law, and whether a new foundation can be constructed for copyright, based on the goal set forth in the Constitution . . . and a tactic by which is achieved, namely, providing incentive to authors and publishers. In this framework, the question would not be whether a copy had been made, but whether a use of a work was consistent with the goal and tactic.<sup>77</sup>

It is in this context that the complex doctrine of fair use may best be used both to shelter the creative transformative work that may use, but not exploit, an underlying work, while protecting the creators of copyrighted material from unfair, exploitative appropriation.

b. *Originality in Derivative Works: Digital Reproductions*

As noted above, a derivative work that is itself non-infringing<sup>78</sup> will be copyrightable to the extent of "the material contributed by the author" of the work. So, too, the Copyright Act expressly contemplates that a reproduction of a work of art may qualify as an independently copyrightable derivative work, again, to the extent of the material contributed by the creator of the reproduction.<sup>79</sup> That contribution, as with any of the material for which copyright protection is sought, must meet the minimal standard of originality (i.e., independent in origin and have some minimal "creativity"). The courts have struggled with the question of what quantum of originality is necessary for a derivative work to be protected. The matter is far from trivial:

The requirement of originality is significant chiefly in connection with derivative works, where if interpreted too liberally it would paradoxically inhibit rather than promote the

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<sup>75</sup> Feist Publ'ns, Inc. v. Rural Tel. Serv. Co., Inc., 499 U.S. 340, 349-350 (1991) (quoting from Justice Brennan's dissenting opinion in *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 U.S. 539 (1985)).

<sup>76</sup> DIGITAL DILEMMA, *supra* note 1.

<sup>77</sup> *Id.* at 232.

<sup>78</sup> The derivative work may be non-infringing because it was created with the consent of the copyright owner of the underlying work, or because the underlying work is in the public domain, or because the derivative work is considered a fair use of the underlying material.

<sup>79</sup> 17 U.S.C. § 101 (Supp. IV 1998).

creation of such works by giving the first creator a considerable power to interfere with the creation of subsequent derivative works from the same underlying work.<sup>80</sup>

Consequently, more is required in the case of derivative works than other works to meet the low originality threshold.<sup>81</sup>

The “originality” question is fairly easily resolved with respect to certain kinds of derivative works. For example, one may easily distinguish the original creative components that go into creating a musical version of a play from the original expression contained in the play itself and thus find the derivative work (the musical) copyrightable to the extent of that added creative material. The matter becomes far more complicated when trying to determine whether a reproduction of a visual work contains sufficient added originality to be a copyrightable derivative work. These complications are seen in a series of opinions by the United States Court of Appeals for the Second Circuit, the court generally considered to be the premier copyright tribunal in the United States. In 1951, in *Alfred Bell & Co. Ltd. v. Catalda Fine Arts, Inc.*,<sup>82</sup> the court held that mezzotint reproductions of public domain oil paintings were copyrightable derivative works, so that one who copied these reproductions without consent was held to be an infringer.<sup>83</sup> The standard for copyrightability of the reproduction was that there be a “distinguishable variation” from the original. Referring to the differences, the court observed:

[E]ven if their substantial departures from the paintings were inadvertent, the copyrights would be valid. The copyist’s bad eyesight or defective musculature or a shock caused by clap of thunder, may yield sufficiently distinguishable variations. Having hit upon such a variation unintentionally, the “author” may adopt it as his and copyright it.<sup>84</sup>

Subsequently, the Federal District Court, relying upon this precedent, held that a highly accurate small-scale reproduction of Rodin’s *Hand of God* was a copyrightable derivative work.<sup>85</sup>

Later cases, both in the Second Circuit and elsewhere, however, have made it clear that for a reproduction to be considered a copyrightable derivative work there

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<sup>80</sup> *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983) (holding that artist’s rendering of Dorothy from *The Wizard of Oz* was not an original derivative work copyrightable under the Copyright Act).

<sup>81</sup> See, e.g., *Entm’t Research Group, Inc. v. Genesis Creative Group, Inc.*, 122 F.3d 1211, 1218–19 (9th Cir. 1997) (“the copyright protection afforded to derivative works is more limited than it is for original works of authorship”).

<sup>82</sup> 191 F.2d 99 (2d Cir. 1951).

<sup>83</sup> *Id.* at 104–05.

<sup>84</sup> *Id.* at 105.

<sup>85</sup> *Alva Studios, Inc. v. Winniger*, 177 F.Supp. 265, 267 (S.D.N.Y. 1959) (“[G]reat skill and originality is called for when one seeks to produce a scale reduction of a great work with exactitude.”).

must be substantial difference or more than a "trivial variation" between it and the underlying work.<sup>86</sup> In the leading case of *L. Batlin & Son, Inc. v. Snyder*,<sup>87</sup> a sharply divided Second Circuit observed:

We follow the school of cases . . . supporting the proposition that to support copyright they must be at least some substantial variation, not merely a trivial variation such as might occur in the translation to a different medium.

Nor can the requirement of originality be satisfied simply by the demonstration of "physical skill" or "special training." A considerably *higher* degree of skill is required, true artistic skill, to make the reproduction copyrightable.<sup>88</sup>

The court went on to state:

Absent a genuine difference between the underlying work of art and the copy of it for which protection is sought, the public interest in promoting progress in the arts—indeed, the constitutional demand . . . could hardly be served. To extend copyrightability to minuscule variations would simply put a weapon for harassment in the hands of mischievous copiers intent on appropriating and monopolizing public domain work.<sup>89</sup>

The court attempted to distinguish its earlier and more expansive holding in *Alfred Bell*.<sup>90</sup> However, later opinions,<sup>91</sup> and the Supreme Court's strong rejection, in *Feist*, of effort alone, or "sweat of the brow," as a substitute for originality,<sup>92</sup> have effectively isolated, if not overruled that earlier approach to copyrightability of derivative works.

The matter was most recently and dramatically dealt with in *The Bridgeman Art Library, Ltd. v. Corel Corporation*.<sup>93</sup> Bridgeman claimed to have acquired the exclusive rights in photographic transparencies, and digital transformations thereof,

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<sup>86</sup> *Gracen v. Bradford Exch.*, 698 F.2d 300, 305 (7th Cir. 1983); *Durham Indus., Inc. v. Tomy Corp.*, 630 F.2d 905, 909 (2d Cir. 1980) (holding that plastic reproductions of Disney figures were not copyrightable); *L. Batlin & Son, Inc. v. Snyder*, 536 F.2d 486, 490 (2d Cir. 1976) (holding copyright of mechanical toy banks invalid for lack of any substantial variation from the original); *Hearn v. Meyer*, 664 F.Supp. 832, 835 (S.D.N.Y. 1987) (holding that reproductions of illustrations by an author were not original, and thus not copyrightable).

<sup>87</sup> 536 F.2d at 486.

<sup>88</sup> *Id.* at 491.

<sup>89</sup> *Id.* at 492.

<sup>90</sup> *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99 (2d Cir. 1951).

<sup>91</sup> In the Second Circuit, see *Durham Industries, Inc. v. Tomy Corp.*, 630 F.2d 905 (2d Cir. 1980), *Bridgeman Art Library, Ltd. v. Corel Corp.*, 36 F.Supp.2d 191 (S.D.N.Y. 1999) ("Bridgeman II"), and *Hearn v. Meyer*, 664 F.Supp. 832 (S.D.N.Y. 1987). See also *Gracen v. Bradford Exch.*, 698 F.2d 300 (7th Cir. 1983).

<sup>92</sup> See *Feist Publ'ns, Inc. v. Royal Tel. Serv. Co., Inc.*, 340, 352–60 (1991).

<sup>93</sup> *Bridgeman II*, 36 F. Supp. 2d at 191.

of well known works of art located in museums around the world; presumably, these rights were acquired from the museums and/or the photographers who created the transparencies, and the Copyright Office had issued to Bridgeman a certificate of registration for the reproductions as derivative works.<sup>94</sup> Bridgeman alleged that Corel had infringed Bridgeman's copyright in 120 reproductions by distributing digital copies thereof without consent.<sup>95</sup> The federal district court held (i) the fact that the Copyright Act expressly refers to "art reproduction" as an example of a derivative work does not obviate the need for meeting the "originality" test as a prerequisite to copyrightability; and (ii) these high-quality photographic reproductions of public domain paintings, as virtually exact, "slavish" copies of the underlying works, do not possess the minimal originality to qualify as copyrightable derivative works.<sup>96</sup>

In this case, plaintiff by its own admission has labored to create "slavish copies" of public domain works of art. While it may be assumed that this required both skill and effort, there was no spark of originality—indeed, the point of the exercise was to reproduce the underlying works with absolute fidelity. Copyright is not available in these circumstances.<sup>97</sup>

As discussed above, and as the *Bridgeman* court acknowledged, "there is little doubt that many photographs, probably the overwhelming majority, reflect at least the modest amount of originality required for copyright protection."<sup>98</sup> The *Bridgeman* case represents the collision between the efficient categorical doctrine holding essentially all photographs copyrightable irrespective of their subject matter or the circumstances of their creation and the originality requirement as applied to derivative works. It has heretofore generally been understood that the physical and technological limitations in reproducing a work of art are such that one may approximate, but not actually duplicate the original. These limitations inevitably leave room for the "substantial variation" justifying including "art reproduction" in the category of derivative works. In a context in which duplication, as opposed to approximation, was a technologically difficult task, it was not necessary for the Copyright Act, in providing examples of derivative works, to encase the phrase "art reproduction" in a limitative cocoon.

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<sup>94</sup> *Bridgeman Art Library, Ltd. v. Corel Corp.*, 25 F. Supp. 2d 421, 423–24 (S.D.N.Y. 1998) (*Bridgeman I*).

<sup>95</sup> *Id.* at 424.

<sup>96</sup> *Bridgeman II*, 36 F. Supp. 2d at 197. In its earlier opinion, *Bridgeman I*, 25 F. Supp. 2d at 421, the court had reached the same conclusion applying the law of the United Kingdom. *Id.* at 426. On reconsideration, in *Bridgeman II*, the court determined that the law of the United States as to "originality" governed. 36 F. Supp. 2d at 195.

<sup>97</sup> *Bridgeman II*, 36 F. Supp. at 197.

<sup>98</sup> *Id.* at 196.

With a technology that facilitates both very close duplication and the worldwide dissemination of duplicated images, the conflict presented by the *Bridgeman* opinion can have quite serious repercussions. Is the "substantial variation" test workable in the context of relatively inexpensive high fidelity digital reproduction of public domain works of art? Certainly, there is a possible threat to the public domain by categorically protecting a photograph whose only function is to duplicate the public domain work. Nevertheless, there is also a social cost to putting at risk one who uses leading-edge technology accurately to duplicate and to disseminate to a broad public important works otherwise accessible only to very few. The issues, and conflicting needs, are more subtle, and have more ramifications for society, than would appear from simple doctrinal analysis.

### III. DOES ONE SIZE FIT ALL?

Much of the preceding discussion could be reframed in terms of the tensions created by attempting to apply, to significantly diverse works, a unitary legal construct whose precepts are purportedly universally applicable. That is, we have a single Copyright Act that purports to apply equally across media, technological, and other boundaries, to any and all "original works of authorship fixed in a tangible medium of expression."<sup>99</sup> The nondiscrimination doctrine, discussed above, is a corollary of that unitary construct. The universal, as opposed to a particularistic, approach to copyright binds together, under one set of standards, works of fiction and fact, poetry and prose, art and architecture, drama and dance, sculpture and software; commonality is found only at the fundamental level of original authorship and fixation.

This framework does not accommodate a society in which differing codes of conduct might apply to different kinds of works. In our daily lives, as well as in our commercial lives, we do not really treat books the same way we treat computer software, even though both are "literary works" for purposes of the Copyright Act;<sup>100</sup> nor do we treat the seemingly ephemeral digital reproductions of musical or artistic works that may appear on our computer screens the same way we treat their more tangible embodiments. While the courts purportedly refrain, we continually make aesthetic judgments and we apply quite different standards in the way we treat works of fine art, television commercials, and photographs. These different standards undoubtedly affect our sense of what is appropriate behavior in dealing with the different products of the creative process. Someone who would, at the very least, feel pangs of guilt in taking paragraphs of material from another's work, might feel much less constrained in "sampling" parts of a musical work. Should our law take these differences into account? Perhaps it would be more appropriate to ask *if* our legal

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<sup>99</sup> 17 U.S.C. § 102(a) (1994).

<sup>100</sup> See § 101.

system is capable of taking these differences into account without sacrificing predictability and a modicum of efficiency.

Certainly, the law as it exists is not nearly as unitary as it purports to be. For example, as noted above, "architectural works" are protected notwithstanding the general principle against protection of utilitarian works, but the protection is not quite as extensive as that afforded to other works.<sup>101</sup> So too, the rights of the owner of copyright in a sound recording are far more limited than those of the copyright owner of the music contained in the recording.<sup>102</sup> In fact, the Copyright Act is liberally salted with special exceptions for particular kinds of works of authorship. Different classes of work may well merit different treatment, with perhaps differing scope of protection and differing definitions of infringing activity. Such particularistic treatment may be most appropriate in the application of the judge-made concept of fair use, recognizing that more latitude is required for certain kind of works than for others. Indeed, the Supreme Court has recognized that "some works are closer to the core of intended copyright protection than others, with the consequence that fair use is more difficult to establish when the former works are copied."<sup>103</sup>

Moreover, there may be other avenues of intervention to enhance the normative function of the law. Areas to explore here might include the peculiar matter of personal/private use of copyrighted material, the use of compulsory licenses, and the role of mass licensing organizations.

#### A. *Personal/Private Use*

There is a general misconception that there really is not anything wrong, legally or morally, with copying for purely personal (as opposed to commercial) use.<sup>104</sup> As the *Digital Dilemma* notes: "This viewpoint is difficult to support on either legal or ethical grounds. It is important to find ways to convince the public to consider thoughtfully the legality, ethics, and economic implications of their acts of private copying:"<sup>105</sup>

[I]ndividuals find themselves capable of reproducing vast amounts of information, in private, using commonplace, privately owned equipment. A single individual can now do in private what once would have required substantial commercial equipment and

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<sup>101</sup> See, e.g., § 120(a):

The copyright in an architectural work that has been constructed does not include the right to prevent the making, distributing, or public display of pictures, paintings, photographs, or other pictorial representations of the work, if the building in which the work is embodied is located in or ordinarily visible from a public place.

<sup>102</sup> § 114.

<sup>103</sup> *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 586 (1994).

<sup>104</sup> See *DIGITAL DILEMMA*, *supra* note 1, at 214, and *supra* text accompanying note 12.

<sup>105</sup> *DIGITAL DILEMMA*, *supra* note 1, at 214.

perhaps criminal intent. One important consequence is that copyright law is becoming more concerned with regulating private behavior of individuals.

Traditionally, copyright has concerned public actions with public consequences, such as public performance, public display, and dissemination of copies (an inherently public act), and has focused on actions of organizations or individuals (like pirates) whose actions have large-scale public consequences. But with computer and communication equipment becoming commonplace in the home, the potential impact of the private behavior of individuals has grown, and so correspondingly has interest in regulating that behavior.<sup>106</sup>

The Copyright Act does not provide broad exemption for private, noncommercial copying, although it does contain a number of very specific exemptions related to private taking of copyrighted material.<sup>107</sup> Particularly in the cultural context of digital copying, manipulation, and wholesale distribution, it is too easy to look at "private" copying as "harmless," if not permissible;<sup>108</sup> "the view is too prevalent that private use copying is virtually always fair use and . . . is often invoked to mask activities that, in the plain light of day cannot be justified."<sup>109</sup> In fact and in many cases the impact of such copying is a market displacement, as the recipient of the copy receives free that which would otherwise be subject to payment of royalties to the copyright owner.<sup>110</sup>

Nevertheless, it is worth exploring whether private use copying has differing impact on different kinds of works and whether, irrespective of case-by-case fair use analysis, the "bundle of rights," the components of the copyright for certain types of works might exclude the purely private taking.<sup>111</sup> Of course, there is the danger of overspecification in defining certain works of authorship differently from others, but

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<sup>106</sup> *Id.* at 46.

<sup>107</sup> *See, e.g., supra* text accompanying note 33.

<sup>108</sup> DIGITAL DILEMMA, *supra* note 1, at 124:

[M]isconceptions [about private copying] concern print, graphics, or other visual content. Some of these are that if the purveyor of the illegal copies is not charging for them or otherwise making a profit, the copying is not an infringement; that anything posted on the Web or on a Usenet newsgroup must be in the public domain by virtue of its presence there; that the First Amendment and fair use doctrine allow copying of virtually any content so long as it is for personal use in a home, rather than redistribution to others; that anything received via email can be freely copied and that if the uploading, posting, downloading, or copying does not, in the view of the end-user, hurt anybody or is just good free advertising, then it is permissible.

<sup>109</sup> *Id.* at 135-36.

<sup>110</sup> *See generally* Chapter 4, *Individual Behavior, Private Use and Fair Use, and the System for Copyright*, in DIGITAL DILEMMA, *supra* note 1.

<sup>111</sup> The very definition of the rights attaching to a given work of authorship may be limited, just as the distribution, performance, and display rights are limited to "public" activities. 17 U.S.C. § 106(3), (4), & (5) (1994 & Supp. IV 1998).



as we have enough experience with digital technology it may become easier to define and determine those kinds of works for which a more flexible copyright structure could harmonize the realities of the marketplace with the legitimate needs of the copyright owners.

### B. *Compulsory Licensing*

One of the significant mediating devices of the Copyright Act is the compulsory license. The compulsory license device, where it applies, is the product of a congressional determination that the principal value of a certain use is economic and that the copyright owner should be satisfied with a fixed compensation for that use. Essentially, with a compulsory license the copyright owner, for a fee, involuntarily relinquishes the right to determine who may exercise certain of the owner's exclusive rights. In exchange for appropriate payment, the copyright owner will be precluded from enforcing the right to exclude and will be deemed to have granted a license to the user.<sup>112</sup>

Prior to passage of the 1976 Act, there was only one significant compulsory license, that "for making and distributing phonorecords."<sup>113</sup> The 1976 Act significantly expanded the use of compulsory licenses, an expansion that continued with the 1998 Digital Millennium Copyright Act.<sup>114</sup> The newer compulsory licenses contemplate industry-wide negotiation leading to the development of appropriate license rates, rather than rates fixed by Congress.

A widely publicized compulsory license scheme would appear to be particularly appropriate for digital images created for general public distribution by owners of digital libraries.<sup>115</sup> Moreover, such a compulsory license arrangement could also cover the right to manipulate images and create derivative works in the same medium. With the certainty of cost and certainty of legality created by the compulsory license mechanism, there is a reasonable possibility that a significant reduction in "piracy" would accompany the setting of reasonable and affordable license rates. Ideally, such an approach would also foster creativity and the development of better digital imaging techniques, much the way the original compulsory license for phonograph recording was the foundation for the growth of a vibrant recording industry.<sup>116</sup>

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<sup>112</sup> See generally HALPERN ET AL., *supra* note 22, § 6.1.2.

<sup>113</sup> 17 U.S.C. § 115 (1994).

<sup>114</sup> Pub. L. No. 105-304, 112 Stat. 2860 (1998) (codified as amended at scattered sections of 17 U.S.C. (Supp. IV 1998)).

<sup>115</sup> The economic trade-off between payment of a set fee and relinquishment of the right to exclude would not seem to be applicable to the case of the individual creator of a visual work not designed for mass distribution.

<sup>116</sup> See HALPERN ET AL., *supra* note 22, § 6.1.2.6.

### C. *Cooperative Rights Licensing Organizations*

Along with the growth of the compulsory licensing device, has been increased interest in cooperative licensing organizations. The paradigm was set by the major music performance rights organizations, the American Society of Composers, Authors, and Publishers (ASCAP) and Broadcast Music, Inc. (BMI). These organizations are designed to enforce the exclusive right of the copyright owner of a musical work publicly to perform that work.<sup>117</sup> Quite apart from the difficulty of any copyright owner tracking live performances of copyrighted works, the vast proliferation of broadcast recorded music makes individual enforcement of performance rights a virtual impossibility. Moreover, there is certainly no general societal consensus as to the desirability of the copyright owner's performance right. Indeed, the right is almost counterintuitive, as one in lawful possession of, for example, a music CD would feel entitled publicly to play that CD notwithstanding a law that make such act infringing.

Nevertheless, collective action, through blanket licenses issued and enforced by ASCAP and BMI, has proven quite successful in generating significant revenues to copyright owners, without hindering the virtually uninterrupted stream of publicly performed music. In this instance, vigorous enforcement, coupled with blanket licenses at affordable fees providing certainty and predictability to the licensee, have proved sufficient to overcome strong public antipathy and resistance to the right being enforced. Similar collective action, in the form of the Copyright Clearance Center, has been effective in limiting unauthorized copying of material from journals, while encouraging limited copying and use of the material for research and similar purposes.<sup>118</sup>

This model of collective action, with broadly based licenses and reasonable rates may well be appropriate for the licensing of rights to widely distributed digital images. It is perhaps a bit early to identify the appropriate stakeholders, but with further development of widely available digital technology that problem should be

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<sup>117</sup> 17 U.S.C. § 106(4) (1994). ASCAP, the first and still largest of the performing rights societies, is essentially a licensing, collection, and distribution body. Its members—composers, authors, and publishers of copyrighted musical works—assign to the society the non-exclusive right to license the small performance rights (the nondramatic musical performance rights) to their works collectively. With the license from the individual members, the society then negotiates blanket licenses with broadcast stations, restaurants, bars, health clubs, and any other entities desiring to perform any of the works. In exchange for payment of the annual fee, the licensee then may exercise the nondramatic musical rights attaching to any and all of the society's works. The accumulated license fees, after expenses, are then distributed to the members more or less on the basis of the frequency of performance of their works, as determined by statistical samples. See generally Bernard Korman & I. Fred Koenigsberg, *Performing Rights in Music and Performing Rights Societies*, 33 J. COPYRIGHT SOC. U.S.A. 332 (1986).

<sup>118</sup> See generally *Am. Geophysical Union v. Texaco, Inc.*, 802 F. Supp. 1 (S.D.N.Y. 1992), *aff'd*, 60 F.3d 913 (2d Cir. 1994).

easily resolved. This approach, of course, changes neither societal perception of right and wrong nor the normative position of applicable copyright law. Rather, it seeks to make compliance easier and more affordable than it currently is by means of a model that encourages broad public dissemination of creative works.

#### IV. *MALUM IN SE, MALUM PROHIBITUM*, AND COMPROMISE

This essay began with an attempt to find and define the normative role of copyright law in the face of the pressures of advanced digital technology, pressures such that the law, even when understood, is often ignored. The task is complicated by the fact that there is widely divergent thinking as to the proper role of copyright in society. As one scholar wrote:

Hostility to copyright has a long and honorable history. . . .

....

... [O]ne need climb no fences to make copies of intellectual products. The restraints are obviously artificial, making the state's hand visible in a way a physical barrier does not. One knows that one is doing something wrong when one tries to sneak into a neighbor's house or pick the lock of another's automobile; it may not seem so obviously wrong to tape a musical recording or duplicate a computer program that is already in hand. In addition, an act of copying seems to harm no one. There is no perceptible loss, no shattered lock or broken fencepost, no blood, not even a psychological sensation of trespass. As a result of all these factors, ordinary citizens may perceive a copyright owner's intangible interest as imposing an "extra" restriction, limiting their liberty in a way that ordinary property does not.

....

[There] seems to be the perception, whether spoken or unspoken, that intellectual property is somehow a "sport," the statutory exception to the common law pattern, imposing unique restraints on liberty.<sup>119</sup>

There is a significant corpus of legal scholarship devoted to the pursuit of justification—or lack of justification—for copyright itself.<sup>120</sup> This work is a serious and important contribution to understanding the foundations of our copyright system. Discussion of the purpose and function of copyright law may guide and inform constructive action. On the other hand, there is little to be learned from polemical debate over whether copyright is a "good" or "bad" institution. Unfortunately, in recent years there has been much gross oversimplification, in which copyright

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<sup>119</sup> Wendy J. Gordon, *An Inquiry into the Merits of Copyright: The Challenges of Consistency, Consent, and Encouragement Theory*, 41 STAN. L. REV. 1343, 1344, 1346–47 (1989).

<sup>120</sup> For a particularly comprehensive, thoughtful, and provocative discussion, see Gordon, *supra* note 119, and Neil Weinstock Netanel, *Copyright and a Democratic Civil Society*, 106 YALE L.J. 283 (1996).

proprietors are demonized and users (authorized or unauthorized) of copyrighted material sanctified. This is done generally in the interest of unstated premises bearing little relation to the reality of copyright and to the fact that the copyright construct is, after more than two hundred years, a fundamental part of the American legal system. That reality, born of both principle and compromise, defies such simplification. Meaningful discussion of accommodation of this complex law to technological exigencies and human behavior must be approached with an open mind, seriously, but without solemnity or stultifying preconceptions.

As we seek a normative approach to copyright, we must be aware of the pressures of globalization and the need for harmonization. It is no longer possible for American law to operate in isolation or disregard of intellectual property laws of the rest of the world and it is therefore no longer sensible to make grand moral pronouncements as to the idiosyncrasies of American law.

American culture, particularly academic culture, has a strong strain of antipathy to copyright ownership—or at least to the rights attendant to such ownership; European culture, at least as embodied in the activities of the European Union, is far more protective of both the economic and personal rights of copyright owners. Thus, while there has been long-standing dispute and struggle over the place of industrial design in American law, the European Community has long provided it *sui generis* protection. Similarly, while Congress and a variety of special interest groups continue to debate the matter, the European Union has issued and implemented a directive creating special protection for databases. So too, the intricately complex fair use doctrine is largely a uniquely American judicial creation.

In general, the European and American approaches to intellectual property and related matters are the products of strikingly different cultural and societal forces. That is not to say that the general public in the European Union operate with greater moral constraints with respect to copyright than does the American public. There are, indeed, comparatively few universally accepted moral precepts related to copyright. Perhaps in this area pragmatism and politics must trump principle.

Certainly, to the extent that copyright law is unnecessarily complex, vigorous commitment to public education as to what is and what is not permissible under the law would be helpful. In *The Digital Dilemma*,<sup>121</sup> the Committee on Intellectual Property Rights and the Emerging Information Infrastructure concludes that:

*Conclusion:* A better understanding of the basic principles of copyright law would lead to great respect for this law and greater willingness to abide by it, as well as produce a more informed public better able to engage in discussions about intellectual property and public policy.

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<sup>121</sup> DIGITAL DILEMMA, *supra* note 1.

*Recommendation:* An educational program should be undertaken that emphasizes the benefits that copyright law provides to all parties. Such a copyright education program needs to be planned and executed with care.<sup>122</sup>

Education, however valuable, does little with respect to conscious disregard of or disrespect for the law, particularly the disregard that is fostered by a technology that makes infringing activity so easy and painless as to leave no mark on the conscience. Much of the conduct that we would call infringing, both in the past and in the context of digital technology, most people would consider “wrong,” *malum in se*; other conduct, that the law would consider infringing, would be shrugged off by many, perhaps with a wink, as merely *malum prohibitum*, “yeah, you’re breaking the law, but how big a law is it?”<sup>123</sup> In between is what might perhaps be called a moral swamp, an area of uncertainty. It is in that context that the much maligned access, circumvention, and copying restrictions of the DMCA may serve a useful purpose. The danger, of course, as discussed above, is that of both overspecification—and the risk of legal constraints being overtaken and made irrelevant by further technological change—and overprotection, with concomitant limitation upon otherwise perfectly lawful and harmless activity and diminution of the public domain as a source of further creativity.

Ultimately, any normative role for copyright law must be as complex and contradictory as the law itself. The digital technology of recent years has significantly upset what was always a precarious balance and it is likely that further refinements to that technology will give rise to even more serious disruption. There is no simple set of “ought” and “ought not” to match the legal precepts of “shall” and “shall not.” I have suggested a few areas of intervention that might serve to narrow, if not bridge the gap between legal precepts and behavior. To some extent, there need to be areas that are *malum prohibitum* while not *malum in se* in order to foster those creative activities consistent with the overall constitutional purpose of copyright law; to some extent there needs to be greater flexibility in the law to foster those creative activities that would otherwise be hampered by the threat of infringement claims. This rather messy, complicated, and compromise-laden schema mirrors our rather messy, complicated, and compromise-laden world, and perhaps that is as it should be.

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<sup>122</sup> *Id.* at 217.

<sup>123</sup> See *supra* note 9 and accompanying text.

